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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/696,894

Applicant(s)

RAMSDEN ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 30, 2003 & October 12, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 77-80 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 77-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/30/03 10/12/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Applicant should note the changes to patent practice and procedure:
  - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
  - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
  - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.
3. **APPLICANT'S REQUEST FOR THE BENEFIT OF AN EARLIER FILING DATE BEFORE 18 APRIL 2000 IS DENIED**, since continuation data as presented on page 1 lacks copendency between pending application serial number 09/551,766 filed on 18 April 2000 and the next application for which this benefit has been requested, that is application serial number 08/845,012 for which the pendency was terminated by a Patented that issued on 03 November 1998. It is noted that there is copendency between each of the remaining application serial numbers 08/842,012; 08/235,290; 07/903,342; & 07/683,243.
  - 3.1 It is noted that application serial number 09/551,776 is a continuation of copending application serial number 09/162,874 which is a continuation of copending application serial number 08/842,012.
4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120/119(e) as follows:
  - A) This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. § 120, § 121, or § 365(c). Copendency between the current application and the prior application is required.
  - B) An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR § 1.78(a)(2) and (a)(5)).
- 4.1 If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application serial numbers 08/842,012; 08/235,290; 07/903,342; & 07/683,243, then a specific

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reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

4.2 If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a

question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

5. The use of various trademark(s), for example: "LabVIEW®" have been noted in this application at paragraph located:

A) at page 34, lines 15-34, "As in the previous embodiments, system 310 ... language such as LabVIEW® available from National Instruments Corp. Such ... interact with potential customers.";

B) between page 48, line 28, and page 48, line 9, "As noted above, system 700 is ... language such as LabVIEW® available from National Instruments Corp. Such ... interact with potential customers.".

Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

5.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. The drawings are objected to because

A) the following errors have been noted in the drawings:

A) the drawings lack fig. 22 as disclosed in the paragraphs located:

(a) at page 45, line 21, "Embodiment of Figures 20-22";

(b) at page 45, lines 22-26, "Figures 20-22 illustrate a stand alone automated shipping system 700 constructed in accordance with a fourth embodiment of the invention for generating an appropriate mailing label for application to a parcel, package or envelope for shipment via a commercial carrier."; and

(c) at page 47, lines 17-27, "Figure 21 illustrates a control system for the embodiment of Figure 20. As in the previous embodiments, the control system illustrated in Figure 21 coordinates the various sensors and input/output devices of the system. As schematically illustrated in Figure 21, the control system includes a microprocessor 718 which

receives inputs from the various components of the system 700 and provides the appropriate control outputs. Operation of the system 700 is preferably controlled by software implemented by microprocessor 718 as will be described in more detail below with respect to Figure 22.”.

B) as can be seen in fig. 22A and from the context of the paragraph located at page 49, lines 23-32, “As shown in Figure 22(A), upon initialization of the system 700 at step 800, the customer is given an option to see and hear a video demonstration illustrating the operation of the system 700. If the customer provides input at step 802 by touching a “demonstration” button 701 (Figure 20) displayed on CRT 702, a 7-10 screen demonstration is displayed at step 804 which is accompanied by screen graphics and voice. The customer may cancel the demonstration at any time by touching a “cancel” button on CRT 702.”, it would seem that the “YES” and “NO” legends for box 802 are reversed, see the related objection below.

6.1 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1,  
with the current status of each of the referenced applications, e.g., --now abandoned--,  
or --now patent #?--, or --which is abandoned and now serial number #?--, --which is  
expired--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification  
lacks an explicit reference to the nature of:

(1) how the program proceeds after box(es):

(a) 552 of fig. 18B if the inquiry is "YES" in the paragraph  
between page 40, line 25 and page 41, line 9, "Upon activation of the  
conveyor belt 340, the inner door motor 248 is also activated at step 546  
to open the inner door to the storage area. However, if an overcurrent is  
detected at step 548 indicating that the storage area is full, an error  
message is sent to the customer at step 550 and an appropriate message  
sent to service personnel. If no overcurrent is detected at step 548,  
sensors 356, 358 and 360 detect movement of the package or envelope  
378 through the inner door 336 until it is detected at step 552 that the  
package has passed through the inner door 336. However, if the parcel  
378 does not pass through the inner door 336 within a predetermined  
amount of time, or if an overcurrent signal is received from the inner  
door motor 248 indicating that the inner door 336 is jammed for some  
reason, an error message is sent to the customer at step 554 and the  
transaction is aborted . As shown in Figure 18B, in the event of such a  
failure, the appropriate message is sent to service personnel, and the  
customer will be issued a receipt indicating that the package has been  
accepted so that the customer may then terminate his or her transaction.  
The conveyor belt 340 is then reset at step 556 f or the next package.";

(b) 802 of fig. 22A if the inquiry is "YES" (as depicted, see  
related objection above) in the paragraph located at page 49, lines 23-32,  
"As shown in Figure 22(A), upon initialization of the system 700 at step

800, the customer is given an option to see and hear a video demonstration illustrating the operation of the system 700. If the customer provides input at step 802 by touching a "demonstration" button 701 (Figure 20) displayed on CRT 702, a 7-10 screen demonstration is displayed at step 804 which is accompanied by screen graphics and voice. The customer may cancel the demonstration at any time by touching a "cancel" button on CRT 702.";

(c) 808 of fig. 22A if the inquiry is "NO" in the paragraph located at page 50, lines 6-15, "Different types of credit or debit cards as well as cash are suitable for payment at step 806. Typically, bank credit cards and vendor issued debit or credit cards are used. At step 808, system 700 checks to see if the card is valid and not recorded in a "bad" card file. However, if cash is selected for payment, this is recorded by the system 700 and is indicated on the label. The cash is then collected by the cashier at the time of depositing the package at the appropriate counter or other designated deposit area.";

(d) 828 of fig. 22B if the inquiry is "YES" in the paragraphs between page, 51, line 31, and page 52, line 14, "Once all of the shipping information has been properly entered, microprocessor 718 then polls scale 706 at step 826 to determine the weight of the parcel or envelope 708. If no weight or an invalid weight is detected at step 828, system 700 prompts the customer at step 830 to place the parcel or envelope 708 on the scale 706. If no weight is detected for a period of time (usually around 30 seconds), system 700 will assume the customer has left and will abort this shipping transaction.

Next, at step 832, system 700 prompts the customer to input the dimensions of the parcel or envelope 708 to be shipped. The customer determines the measurements using measuring grid 710 adjacent scale 706. Screen graphics on CRT 702 help the customer in this process by



illustrating how the dimensions of the package are to be measured using the measuring grid 710. System 700 then determines at step 834 whether the input dimension data is valid and issues an appropriate message at step 836 if the dimensions are, for example, too large to be handled at that location. The customer is then given another opportunity to enter the dimensions at step 832 to correct any errors.”;

(e) 844 of fig. 22B if the inquiry is “YES” in the paragraphs between page, 52, line 26, and page 53, line 10, “CRT 702 next displays a shipping label at step 842. The customer is given an opportunity at step 844 to check its accuracy and to edit it as required at step 846. If the zip code is edited at step 846, system 700 goes back and recalculates the shipping charges and gives the customer another opportunity to select the service options at step 840. This is necessary because the shipping charges will probably be different when the shipping address is changed. Also, the customer may be given another chance to select data in the consignee file. Data in the consignee file also will be updated to reflect any address changes. Any other changes may be made without requiring recalculations and system 700 may continue processing the shipment. As in the previous embodiment, tracking information such as bar code labels and the like may also be applied to the label if they are of use to the carrier.

The label is then printed at step 848. A screen and voice prompt will instruct the customer to apply the label to the parcel or envelope as illustrated on CRT 702. The label preferably has a backing that may be peeled off by the customer so that the label may be readily stuck to the parcel or envelope 708.”.

In this regard, it is noted that merely mentioning either a feature or a number without mentioning the device or operation or number or feature relies on the drawing to

provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

A) as can be seen in fig. 18A and from the disclosure between page 38, line 21, and page 39, line 8, "Once all of the shipping information has been properly entered, the delivery date and cost for each delivery service available to the customer is computed at step 526. In computing the delivery date, the software takes into account weekends, holidays and other days in which no delivery service is available when calculating for each service when the package can be expected to be delivered. The cost for each available delivery service is also calculated using the weight and dimensioning information as well as the destination data. The delivery date and cost for all available service options are then displayed to the customer on the CRT 322. This allows the customer to make an informed judgment regarding which delivery service is desired on the basis of cost and projected delivery date. The customer may also be given an opportunity to select weekend delivery, as available. The customer then selects the desired service option at 528. For example, the customer may select second day air for Saturday delivery. All data regarding the customer's selection is then displayed to the customer on CRT 322 so that the customer can determine at step 530 whether all of the proper information has been provided. If so, the label is printed at step 534. If not, the customer is given an opportunity at step 562 to edit this information before the label is printed at step 534.", at line 24 of this paragraph "562" should be -532--.

B) as can be seen in figs. 22A, 22B & 22C and from the context of the disclosure in the paragraphs located:

(a) at page 45, line 21, "Embodiment of Figures 20-22";

(b) at page 45, lines 22-26, "Figures 20-22 illustrate a stand alone automated shipping system 700 constructed in accordance with a fourth embodiment of the invention for generating an appropriate mailing label

for application to a parcel, package or envelope for shipment via a commercial carrier.”; and

(c) at page 47, lines 17-27, “Figure 21 illustrates a control system for the embodiment of Figure 20. As in the previous embodiments, the control system illustrated in Figure 21 coordinates the various sensors and input/output devices of the system. As schematically illustrated in Figure 21, the control system includes a microprocessor 718 which receives inputs from the various components of the system 700 and provides the appropriate control outputs. Operation of the system 700 is preferably controlled by software implemented by microprocessor 718 as will be described in more detail below with respect to Figure 22.”;

each reference to fig. 22 should be –Figures 22A, 22B and 22C--.

Appropriate correction is required.

8. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

9. Claims 77-80 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9.1 In regard to claims 77-80, although on of ordinary skill at the time of the invention would known how to accomplish each of the individual recited actions/functions from the language of these claims, since there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claim 77, it is unclear how the processor of lines 12-13, "a processor for receiving said package type information and computing a cost for mailing said package to said destination as a function of its weight", how the "package type information" may be used by the processor, since this information is not entered into the system so that the processor may obtain this information;

B) in regard to claim 77, it is unclear how the processor of lines 12-13, "a processor for receiving said package type information and computing a cost for mailing said package to said destination as a function of its weight", how the cost for a delivery service may be determined as a function of the destination and weight, since the processor does not receive either:

(1) the weight from the recited "scale"; or

(2) the "delivery service options" information from the recited "input system"; or

(3) the destination information from the recited "input system";

so that these values may be used to determine the cost for a delivery service.

C) in regard to claim 77, it is unclear how the printer of lines 14-17, "a printer responsive to said processor so as to print a label identifying at least said destination representative information and to print a shipping receipt for an amount including at least the cost of delivering said parcel or envelope to said destination via the delivery service chosen by said customer.", how a label may be printed with the "destination information", since neither the processor nor printer receive this information from the recited "input system" so that it may be printed on the label;

D) in regard to claim 77, it is unclear how the printer of lines 14-17, "a printer responsive to said processor so as to print a label identifying at least said destination representative information and to print a shipping receipt for an amount including at least the cost of delivering said parcel or envelope to said destination via the delivery service chosen by said customer.", how a receipt may be printed with an "amount including at least the cost" via the "delivery service chosen by said customer", since neither the processor nor the printer receives either:

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(1) the "delivery service options" information from the recited "input system"; or

(2) the destination information from the recited "input system";

so that these values may be used when printing the receipt.

E) in regard to claim 77, how the recited system would comprise an operative system, since this claims merely recites an aggregation of parts, since the "receiving means", the "scale" and the "input system" which are not recited as being operatively interconnected to the "processor" and "print" so as to operatively provide the functions/operations that are recited in the claims.

9.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

10. Claims 77-80 are provisionally rejected under the judicially created doctrine of double patenting over claims 76-77 of copending Application No. 09/551,766. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

10.1 Claims 77-80 are rejected under the judicially created doctrine of double patenting over either:

A) claims 1-59 of U. S. Patent No. 5,656,799; or

B) claims 1-4 of U. S. Patent No. 5,831,220; or

C) claim 1 of U. S. Patent No. 6,105,014;

since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

10.2 The subject matter claimed in the instant application is fully disclosed in the referenced Patents and copending application and would be covered by any patent granted on that copending application since the referenced Patents and copending application and the instant application are claiming common subject matter, in the nature of a basic system, as follows:

A) a means to receive a payment;

B) a scale to weigh an item to be mailed;

C) an input means to enter into the system information regarding a delivery service, the destination, and rating information regarding the item to be mailed;

D) a means to use the entered information to determine the correct shipping charges/fees; and

E) a printer to print an appropriate shipping label and a customer receipt.

Where the claims of the indicated referenced Patents and copending application contain additional details of features which would be covered by basic invention as recited in the claims of the instant application, since the claims of the instant application would cover the basic systems/methods recited in the claims in the indicated referenced Patents and copending application regardless of whether or not the additional features of the methods/systems recited in the claims of the indicated referenced Patents and copending application are present.

10.3 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

10.4 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

10.5 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

11.1 Claims 77-80 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

11.1.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), "We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 "14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”; and “Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

11.1.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

11.1.3 As can be seen from claims 77-80, these claims are directed to a series of devices for performing various functions, which as set forth above in regard to the rejection of claims 77-80 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system within the meaning of machine or process as used in 35 U.S.C. § 101.

11.2 Claims 77-80 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 77-80, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 112 2<sup>nd</sup> paragraph as set forth above.



B) in regard to claims 77-80, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 102 as set forth below.

C) in regard to claims {fill in}, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 103 as set forth below.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12.1 Claim 77 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Gunn (4,024,380) or Wright et al (4,802,218) or Pusic (5,065,000) or Ramsden (5,340,948 or 5,369,221 or 5,481,464 or 5,656,799) or Kara et al (5,778,076 or 5,801,364) or Whitney et al (5,796,834) or Kara (5,812,991) or Ramsden et al (5,831,220).

12.2 Claim 77 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by either Kara (6,233,568) or Ramsden et al (6,105,014).

12.3 In regard to claim 77, either Gunn ('380) or Wright et al ('218) or Pusic ('000) or Ramsden ('948 or '221 or '464 or '799) or Kara et al ('076 or '364) or Whitney et al ('834) or Kara ('991 or '568) or Ramsden et al ('220 or '014) disclose a mailing system/method that include:

A) a means for receiving payment for the dispensed postage or shipping fee;

B) a scale for weighing the item to be mailed or shipped;

C) an input device for entering:

- (1) the destination of the item to be mailed or shipped;
- (2) an indication of the selected services provided by the carriers; and
- (3) an indication of the any other required postage or shipping fee determining/related information;

D) a device to determine the required postage or shipping fee as a function of at least the weight of the item and entered destination for the item; and

E) at least one device to print a shipping label for the item and a customer receipt for the postage or shipping fee that has been paid.

12.4 Claim 78 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Wright et al (4,802,218) or Pusic (5,065,000) or Ramsden (5,656,799) or Kara et al (5,778,076 or 5,801,364) or Whitney et al (5,796,834) or Kara (5,812,991) or Ramsden et al (5,831,220).

12.5 Claim 78 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by either Kara (6,233,568) or Ramsden et al (6,105,014).

12.6 In regard to the use of a barcode on the printed label in claim 78, either Wright et al ('218) or Pusic ('000) or Ramsden ('799) or Kara et al ('076 or '364) or Whitney et al ('834) or Kara ('991 or '568) or Ramsden et al ('220 or '014) disclose that the printed label includes a barcode.

12.7 Claim 79 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Ramsden (5,340,948 or 5,369,221 or 5,481,464 or 5,656,799) or Ramsden et al (5,831,220).

12.8 Claim 79 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Ramsden et al (6,105,014).

12.9 In regard to the use of a touch screen CRT in claim 79, either Ramsden ('948 or '221 or '464 or '799) or Ramsden et al ('220 or '014) disclose the use of a touch screen as a user input device.

12.10 Claim 80 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Pusic (5,065,000) or Ramsden (5,340,948 or 5,369,221 or 5,481,464 or 5,656,799) or Ramsden et al (5,831,220).

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12.11 Claim 80 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Ramsden et al (6,105,014).

12.12 In regard to the use of a credit card reader in claim 80, either Pusic ('000) or Ramsden ('948 or '221 or '464 or '799) or Ramsden et al ('220 or '014) disclose the use of a credit card reader by the user when making a payment.

13. The examiner has cited prior art, for example:

A) either Gilham (EP 331352 or 4,934,846) or Connell et al (EP 356,228) or Haug (5,191,533) or Babyak or the Business Wire article, which disclose that the destination, size and weight of an item to be mailed are consideration when determining the required shipping fee for the item.

B) either Barrett (lines 11-24) or Piccione (4,495,581) or Barns-Slavin et al (5,117,364), which disclose the practice of rate shopping, that is determining the shipping fee for a number of carriers tat provide similar services so as find the lowest shipping fee for an item.

C) the Business Wire article, which further discloses that although the characteristics of a shipment ant the transit time were considered by a shipper in the 1990's when selecting a carrier, the delivery date, distance to the destination, size, weigh and value of an item to be mailed are now the factors considered by a shipper when selecting a carrier.

D) Oh et al (5,446,667), which disclose logistically determining a delivery dates for each stage of a shipment from an origin to a destination so that the shipment will be delivered to it's final destination as desired by the customer.

E) Moore (5,917,925), which discloses the application of unique information based on the origin, destination, and postage to an item being shipped that may be used to track postage.

13.1 The prior art cited but not supplied to applicant has been considered and was cited either by applicant or during the prosecution of the parent applications.

14. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

15.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

15.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

15.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

12/15/04



**Edward R. Cosimano**  
**Primary Examiner A.U. 3629**